

REMARKS

The Office Action mailed July 18, 2006 has been carefully reviewed and the foregoing amendment has been made in consequence thereof.

Claims 1-3 and 5-21 are now pending in this application. Claims 1-3 and 5-8 stand rejected. Claims 9-21 are newly added. No additional fee is due for newly added Claims 9-21.

The rejection of Claims 1-3, 5, 6 and 8 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent 6,364,329 to Holub et al. (hereinafter referred to as "Holub") in view of Spykerman, of record, is respectfully traversed.

Holub describes a cooler (100) including a lid (110) formed using conventional blow molding techniques. The lid (110) includes cup holders (116). Notably, Holub does not teach or suggest an expandable beverage holder that is movable between a collapsed configuration and an expanded configuration, wherein, in the expanded configuration, the expandable beverage holder is configured to hold a beverage container.

Spykerman describes a container holder (10) including cup-shaped members (18, 20) that are movable between a lowered recessed position, as shown in Figure 2, for holding a larger diameter container and a raised extended position, as shown in Figure 3, for holding a smaller diameter container. Notably, Spykerman does not teach or suggest an expandable beverage holder that is movable between a collapsed configuration and an expanded configuration, wherein, in the expanded configuration, the expandable beverage holder is configured to hold a beverage container.

Applicants respectfully submit that the Section 103 rejection of the presently pending claims is not a proper rejection. As is well established, obviousness cannot be established by combining the teachings of the cited art to produce the claimed invention, absent some teaching, suggestion, or incentive supporting the combination. Neither Holub nor Spykerman, considered alone or in combination, describes or suggests the claimed combination. Further, in contrast to the Examiner's assertion within the Office Action,

Applicants respectfully submit that it would not be obvious to one skilled in the art to combine Holub and Spykerman, because there is no motivation to combine the references suggested in the art. Additionally, the Examiner has not pointed to any prior art that teaches or suggests to combine the disclosures, other than Applicants' own teaching. Rather, only the conclusory statement that "it would have been obvious to one of ordinary skill in the art at the time the invention was made to have incorporated the expandable feature of the beverage holder disclosed by Spykerman in the top panel of the container of Holub ..." suggests combining the disclosures.

As the Federal Circuit has recognized, obviousness is not established merely by combining references having different individual elements of pending claims. Ex parte Levengood, 28 U.S.P.Q.2d 1300 (Bd. Pat. App. & Inter. 1993). MPEP 2143.01. Rather, there must be some suggestion, outside of Applicants' disclosure, in the prior art to combine such references, and a reasonable expectation of success must be both found in the prior art, and not based on Applicant's disclosure. In re Vaeck, 20 U.S.P.Q.2d 1436 (Fed. Cir. 1991). In the present case, neither a suggestion nor motivation to combine the prior art disclosures, nor any reasonable expectation of success has been shown.

Further, it is impermissible to use the claimed invention as an instruction manual or "template" to piece together the teachings of the cited art so that the claimed invention is rendered obvious. Specifically, one cannot use hindsight reconstruction to pick and choose among isolated disclosures in the art to deprecate the claimed invention. Further, it is impermissible to pick and choose from any one reference only so much of it as will support a given position, to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one of ordinary skill in the art. The present Section 103 rejection is based on a combination of teachings selected in an attempt to arrive at the claimed invention. Since there is no teaching or suggestion in the cited art for the combination, the Section 103 rejection appears to be based on a hindsight reconstruction in which isolated disclosures have been picked and chosen in an attempt to deprecate the present invention. Of course, such a combination is impermissible, and for this reason alone, Applicants request that the Section 103 rejection be withdrawn.

Neither Holub nor Spykerman, considered alone or in combination, describes or suggests an expandable beverage holder, e.g., a beverage holder that is movable between a collapsed configuration and an extended configuration.

If art “teaches away” from a claimed invention, such a teaching supports the nonobviousness of the invention. U.S. v. Adams, 148 USPQ 479 (1966); Gillette Co. v. S.C. Johnson & Son, Inc., 16 USPQ2d 1923, 1927 (Fed. Cir. 1990). In light of this standard, it is respectfully submitted that the cited art, as a whole, is not suggestive of the presently claimed invention. Moreover, Applicants respectfully submit Holub and Spykerman each teach away from the expandable beverage holder, as recited in Claim 1. Specifically, Holub is directed to a molded lid defining cup holders and Spykerman is directed to a cup-shaped member that is movable between expanded configurations but is not collapsible. As such, neither Holub nor Spykerman, either alone or in combination, describes or suggests “... an expandable beverage holder configured to couple to the cover, the expandable beverage holder movable between a collapsed configuration and an expanded configuration, in the expanded configuration the expandable beverage holder configured to hold a beverage container, ...” as recited in Claim 1. Accordingly, Applicants respectfully submit that the cited art as a whole teaches away from the expandable beverage holder as recited. Moreover, Applicants traverse the suggestion in the Office Action at paragraph 3 that “it would have been obvious to one of ordinary skill in the art at the time the invention was made to have incorporated the expandable feature of the beverage holder disclosed by Spykerman in the top panel of the container of Holub ...” For the reasons stated above, Applicants submit that the limitations of Claim 1 are not obvious in view of the cited art.

Moreover, and to the extent understood, neither Holub nor Spykerman, considered alone or in combination, describes nor suggests the claimed invention. Specifically, Claim 1 recites an insulated container comprising “... an expandable beverage holder configured to couple to the cover, the expandable beverage holder movable between a collapsed configuration and an expanded configuration, in the expanded configuration the expandable beverage holder configured to hold a beverage container, a bottom of the expandable beverage holder configured to prevent heat transfer.”

Neither Holub nor Spykerman, considered alone or in combination, describes or suggests the insulated container, as recited in Claim 1. More specifically, neither Holub nor Spykerman, considered alone or in combination, describes or suggests an expandable beverage holder configured to couple to the cover, the expandable beverage holder movable between a collapsed configuration and an expanded configuration, in the expanded configuration the expandable beverage holder configured to hold a beverage container,” as required by Applicants’ claimed invention. Rather, in contrast to the present invention, Holub describes a molded lid defining cup holders and Spykerman describes a cup-shaped member that is movable between expanded configurations but is not collapsible.

Accordingly, for at least the reasons set forth above, Claim 1 is submitted to be patentable over Holub in view of Spykerman.

Claims 2, 3, 5, 6 and 8 depend from independent Claim 1. When the recitations of Claims 2, 3, 5, 6 and 8 are considered in combination with the recitations of Claim 1, Applicants submit that dependent Claims 2, 3, 5, 6 and 8 likewise are patentable over Holub in view of Spykerman.

For the reasons set forth above, Applicants respectfully request that the Section 103 rejection of Claims 1-3, 5, 6 and 8 be withdrawn.

The rejection of Claims 1-3 and 5-8 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent Application Publication 2005/0072181 to Mogil et al. (hereinafter referred to as “Mogil”) in view of Spykerman, of record, is respectfully traversed.

Mogil describes an insulated container including a lid (334) including circular recesses or depressions (342) to steady a beverage placed therein.

Spykerman is described above.

Applicants respectfully submit that the Section 103 rejection of the presently pending claims is not a proper rejection. As is well established, obviousness cannot be established by combining the teachings of the cited art to produce the claimed invention, absent some

teaching, suggestion, or incentive supporting the combination. Neither Mogil nor Spykerman, considered alone or in combination, describes or suggests the claimed combination. Further, in contrast to the Examiner's assertion within the Office Action, Applicants respectfully submit that it would not be obvious to one skilled in the art to combine Mogil and Spykerman, because there is no motivation to combine the references suggested in the art. Additionally, the Examiner has not pointed to any prior art that teaches or suggests to combine the disclosures, other than Applicants' own teaching. Rather, only the conclusory statement that "it would have been obvious to one of ordinary skill in the art at the time the invention was made to have incorporated the expandable feature of the beverage holder disclosed by Spykerman in the top panel of the container of Mogil ..." suggests combining the disclosures.

As the Federal Circuit has recognized, obviousness is not established merely by combining references having different individual elements of pending claims. Ex parte Levensgood, 28 U.S.P.Q.2d 1300 (Bd. Pat. App. & Inter. 1993). MPEP 2143.01. Rather, there must be some suggestion, outside of Applicants' disclosure, in the prior art to combine such references, and a reasonable expectation of success must be both found in the prior art, and not based on Applicant's disclosure. In re Vaeck, 20 U.S.P.Q.2d 1436 (Fed. Cir. 1991). In the present case, neither a suggestion nor motivation to combine the prior art disclosures, nor any reasonable expectation of success has been shown.

Further, it is impermissible to use the claimed invention as an instruction manual or "template" to piece together the teachings of the cited art so that the claimed invention is rendered obvious. Specifically, one cannot use hindsight reconstruction to pick and choose among isolated disclosures in the art to deprecate the claimed invention. Further, it is impermissible to pick and choose from any one reference only so much of it as will support a given position, to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one of ordinary skill in the art. The present Section 103 rejection is based on a combination of teachings selected in an attempt to arrive at the claimed invention. Since there is no teaching or suggestion in the cited art for the combination, the Section 103 rejection appears to be based on a hindsight reconstruction in which isolated

disclosures have been picked and chosen in an attempt to deprecate the present invention. Of course, such a combination is impermissible, and for this reason alone, Applicants request that the Section 103 rejection be withdrawn.

Neither Mogil nor Spykerman, considered alone or in combination, describes or suggests an expandable beverage holder, e.g., a beverage holder that is movable between a collapsed configuration and an extended configuration.

If art “teaches away” from a claimed invention, such a teaching supports the nonobviousness of the invention. U.S. v. Adams, 148 USPQ 479 (1966); Gillette Co. v. S.C. Johnson & Son, Inc., 16 USPQ2d 1923, 1927 (Fed. Cir. 1990). In light of this standard, it is respectfully submitted that the cited art, as a whole, is not suggestive of the presently claimed invention. Moreover, Applicants respectfully submit Mogil and Spykerman each teach away from the expandable beverage holder, as recited in Claim 1. Specifically, Mogil is directed to a molded lid defining circular recesses or depressions to steady a beverage placed therein and Spykerman is directed to a cup-shaped member that is movable between expanded configurations but is not collapsible. As such, neither Mogil nor Spykerman, either alone or in combination, describes or suggests “... an expandable beverage holder configured to couple to the cover, the expandable beverage holder movable between a collapsed configuration and an expanded configuration, in the expanded configuration the expandable beverage holder configured to hold a beverage container ...” as recited in Claim 1. Accordingly, Applicants respectfully submit that the cited art as a whole teaches away from the expandable beverage holder as recited. Moreover, Applicants traverse the suggestion in the Office Action at paragraph 3 that “it would have been obvious to one of ordinary skill in the art at the time the invention was made to have incorporated the expandable feature of the beverage holder disclosed by Spykerman in the top panel of the container of Mogil ...” For the reasons stated above, Applicants submit that the limitations of Claim 1 are not obvious in view of the cited art.

Moreover, and to the extent understood, neither Mogil nor Spykerman, considered alone or in combination, describes nor suggests the claimed invention. Specifically, Claim 1 recites an insulated container comprising “... an expandable beverage holder configured to

couple to the cover, the expandable beverage holder movable between a collapsed configuration and an expanded configuration, in the expanded configuration the expandable beverage holder configured to hold a beverage container, a bottom of the expandable beverage holder configured to prevent heat transfer.”

Neither Mogil nor Spykerman, considered alone or in combination, describes or suggests the insulated container, as recited in Claim 1. More specifically, neither Mogil nor Spykerman, considered alone or in combination, describes or suggests an expandable beverage holder configured to couple to the cover, the expandable beverage holder movable between a collapsed configuration and an expanded configuration, in the expanded configuration the expandable beverage holder configured to hold a beverage container,” as required by Applicants’ claimed invention. Rather, in contrast to the present invention, Mogil describes a molded lid defining circular recesses or depressions to steady a beverage placed therein and Spykerman describes a cup-shaped member that is movable between expanded configurations but is not collapsible.

Accordingly, for at least the reasons set forth above, Claim 1 is submitted to be patentable over Mogil in view of Spykerman.

Claims 2, 3 and 5-8 depend from independent Claim 1. When the recitations of Claims 2, 3 and 5-8 are considered in combination with the recitations of Claim 1, Applicants submit that dependent Claims 2, 3 and 5-8 likewise are patentable over Mogil in view of Spykerman.

For the reasons set forth above, Applicants respectfully request that the Section 103 rejection of Claims 1-3 and 5-8 be withdrawn.

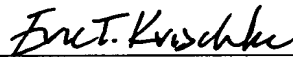
With respect to newly added Claim 9-21, Applicants respectfully submit that none of the cited art describes “an expandable beverage holder movable between a collapsed configuration and an expanded configuration, in the expanded configuration the expandable beverage holder configured to hold a beverage container,” as set forth in independent Claims 9 and 21.

Therefore, Applicants submit that Claims 9 and 21 are patentable over the cited art.

Newly added Claims 10-20 depend from independent Claim 9. When the recitations of these claims are considered in combination with the recitations of Claim 9, Applicants submit that Claims 10-20 likewise are patentable over the cited art.

In view of the foregoing amendments and remarks, all the claims now active in this application are believed to be in condition for allowance. Reconsideration and favorable action is respectfully solicited.

Respectfully submitted,



Eric T. Krischke
Registration No. 42,769
ARMSTRONG TEASDALE LLP
One Metropolitan Square, Suite 2600
St. Louis, Missouri 63102-2740
(314) 621-5070